REMARKS

Claims 1-16 and 30-43 are pending in the instant application.

Response to Restriction Requirement

The Examiner has required restriction of the pending claims under 35 U.S.C. § 121 to one of the following 10 groups:

I. Claims 1-16 and 30-33, drawn to a method of identifying a compound which binds to a coactivator binding site of a human thyroid beta receptor, classified in class 702, subclass 19.

II. Claims 1 and 34-35, drawn to a method of identifying a compound which binds to a coactivator binding site of a human estrogen receptor, classified in class 702, subclass 19.

III. Claims 1 and 36, drawn to a method of identifying a compound which binds to a coactivator binding site of hRARγ, classified in class 702, subclass 19.

IV. Claims 1 and 37, drawn to a method of identifying a compound which binds to a coactivator binding site of hRXRα, classified in class 702, subclass 19.

V. Claims 1 and 38, drawn to a method of identifying a compound which binds to a coactivator binding site of hPPARγ, classified in class 702, subclass 19.

VI. Claims 1 and 39, drawn to a method of identifying a compound which binds to a coactivator binding site of hVDR, classified in class 702, subclass 19.

VII. Claims 1 and 40, drawn to a method of identifying a compound of identifying a compound which binds a coactivator binding site of hGR, classified in class 702, subclass 19.

VIII. Claims 1 and 41, drawn to a method of identifying a compound which binds to a coactivator binding site of hPR, classified in class 702, subclass 19.

IX. Claims 1 and 42, drawn to a method of identifying a compound which binds to a coactivator binding site of hMR, classified in class 702, subclass 19.

X. Claims 1 and 43, drawn to a method if identifying a compound which binds to a coactivator binding site of hAR, classified in class 702, subclass 19.

Provisional Election

The present response is intended to be fully responsive to the restriction requirement issued by the Examiner. Applicants hereby provisionally elect to prosecute the claims of **Group I**, claims 1-16 and 30-33, drawn to a method of identifying a compound which binds a coactivator binding site of a human thyroid beta receptor, classified in class 702, subclass 19, with traverse.

Traversal

With respect to the Examiner's division of the invention into ten groups of claims and the reasons stated therefor, Applicants respectfully traverse.

Applicants submit that to search and examine the subject matter of all the groups together would not be a serious burden on the Examiner. The claims in the instant application are drawn to a method of identifying a compound that binds to a coactivator site of a nuclear receptor. The M.P.E.P. § 803 (Eighth Edition, August 2001) states:

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

By the Examiner's admission, the receptors of all ten groups are classified in the same search class (702) and the same subclass (19). Additionally, the receptors are all in a generic class that lends itself to a single search. Accordingly, it would not be unduly burdensome to search all of the receptor subtypes simultaneously because the entire family could be accessed with a single search.

Furthermore, claim 1 was not previously restricted to a species of receptor by the Examiner before examination, hitherto, on the merits. The Examiner has thus admitted that the subject matter of the invention is searchable by having already examined the generic claim on the merits. To now subject the claims to a Restriction requirement, after a search and examination on the merits has already been undertaken, is improper.

Thus, in view of M.P.E.P. § 803, all of the receptors generically recited by Claim 1 should be searched and examined in the subject application. Accordingly, Applicants respectfully request that the Restriction Requirement Under 35 U.S.C. § 121 be withdrawn and the instant claims be examined in one application.

Furthermore, because the Examiner has presented claim 1 in all of the 10 groups, it is unclear whether it is the Examiner's intention to limit claim 1 to the species presented in each group, or whether the Examiner intends to treat claim 1 as a generic claim. Applicants respectfully request clarification from the Examiner in this regard.

If the Examiner does indeed seek to divide claim 1 up across multiple groups, Applicants respectfully object for the following reasons. An applicant has a right to define what he or she regards as the invention, so long as their definition is distinct and supported by Section 112. *In re Harnisch*, 206 USPQ 300 (CCPA 1980) Additionally, according to *In re Weber*, 198 USPQ 328 (CCPA 1978),

an applicant has the right to have each claim examined on the merits. Accordingly, it is inappropriate to impose a restriction requirement upon the subject matter of a single claim, because it would deny the applicant the right to have the restricted claim examined on the merits. As stated in *In re Weber*,: "if ... a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits." *In re Weber*, 198 USPQ at 331. Forcing Applicants to carve their class of nuclear receptors into many receptor subtypes across several patent applications would be extremely prejudicial to Applicants, and is contrary to the spirit of *In re Weber* and MPEP § 803, as presented hereinabove. Indeed, the generic class of receptors recited in Claim 1 is broader than the number of specific receptors recited in the dependent claims in the 10 groups identified by the Examiner. Thus, to carve up claim 1 would be to curtail its scope.

As previously discussed, Applicants have invented a method, applicable to a class of receptors, that is defined by way of a generic claim. Forcing Applicants to carve their generic claim into several pieces would be simply improper. In so doing, the Examiner would be defining Applicants' invention rather than the Applicants. While the Patent Office has a legitimate interest in dividing applications directed to dissimilar inventions, where, as here, the various inventions are so inextricably intertwined that they are properly described by a generic claim, the Office's administerial interests must give way to Applicants' interest in properly defining their invention. Because of these considerations, forcing the Applicants to carve up a generic claim would be contrary to Applicants' statutory right to claim their invention in the manner necessary to properly circumscribe it, as well as tantamount to a refusal to examine. Accordingly, the restriction requirement as issued by the Examiner is improper.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully request that the above-made remarks be made of record in the file history of the present application.

Amendments to the Specification

In view of the Examiner's comment, in her office action mailed February 6, 2003, that Applicants' amendments to the specification, presented in their response dated November 18, 2003, have not been entered, Applicants have presented them again, hereinabove. In particular, Applicants the Examiner to the comments in their response dated November 18, 2003.

Applicants have amended the specification at pages 36, 41 and 43, to include SEQ ID NOs for the sequences of protein fragments presented in the Protein Data Bank (PDB) files found in, respectively, Appendices 1–3 of the specification as filed. The specification at page 36 has

additionally been amended to incorporate remarks found in the headers to the PDB files of Appendix 1 (specification as filed, page 74, lines 9-20).

Applicants have also amended the specification to correct a number of minor typographical errors, on pages 3, 4, 10, 11, and 18. In particular, the spelling of the word "spatially" has been corrected on pages 3, 4, 10, 11, and 18. The spelling of the word "interactive" has been corrected on page 18. Additionally, the amino acid residue denoted "V284" has been written out in full, according to standard 3-letter amino acid abbreviations, as "Val 284" on page 10. Accordingly, no new matter has been introduced by way of these amendments to the specification, and entry thereof is respectfully requested.

CONCLUSION

Applicants hereby provisionally elect, with traverse, to prosecute the claims of **Group I**, claims 1-16 and 30-33. Applicants have also re-presented, at the Examiner's request, amended paragraphs of the specification. Applicants respectfully submit that all pending Claims of the instant Application satisfy the requirements for patentability and are in condition for allowance. An early indication of the same is therefore respectfully requested.

A Petition for an Extension of Time accompanies this request. Applicants believe no other fee is due in connection with this response. However, the Commissioner is authorized to charge all required fees, fees under 37 C.F.R. § 1.17, and all required extension of time fees, or credit any overpayment, to Pennie & Edmonds LLP U.S. Deposit Account No. 16-1150. (9811-008-999).

Respectfully submitted,

Date: 4/7/03

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Limited Recognition Under 37 C.F.R. § 10.9(b)
(Copy of Certificate attached hereto)

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